

REMARKS

Applicant respectfully traverses the Examiner's rejection of claim 1 under 35 U.S.C. § 103(a) as being unpatentable over D'Amelio et al., U.S. Patent No. 5,647,840, in view of Thompson, U.S. Patent Application Publication No. 2002/0028986, and further in view of Yarush et al., U.S. Patent No. 6,692,432. Applicant has amended claim 1 of the present application to describe the hemispherical concave shape of the portion of the fiber optic bundles that cover the surface of the LED light source at 36. New claim 2 has also been added to disclose that the hemispherical concave shape is preferred so that each fiber optic strand can transmit the maximum light from LED 34 to the distal end 22 of the endoscopic tube 12. This information was previously disclosed in paragraph [0021] of the present application and is illustrated in Figures 2, 4, and 5, and therefore, does not constitute new matter. The prior art references cited by the Examiner do not disclose that the proximal end of the fiber optic bundle in those references is a hemispherical concave shape to surround an LED light source, thereby achieving maximum transmission of the light produced and emitted by the LED light source. The proximal end of the fiber optic bundle in Yarush et al. is illustrated as having a flat or planar end that does not surround or envelope the light source, but rather, flatly contacts an end portion of the bulb in that invention. See Yarush et al., Figures 18 and 27. Furthermore, the Yarush invention uses a sleeve 430 to capture additional light from bulb 100 and to direct the captured light towards lens fiber bundle 112. See Yarush et al., column 15, lines 41-51, and Figures 17-19. However, Applicant's invention uses the hemispherical concave shape of the proximal end of the fiber optic bundle to surround the LED light source to capture light. Thus, the

Examiner's rejection of claim 1 under 35 U.S.C. § 103(a) cannot be sustained.

In addition, on page 3 of the Office Action, the Examiner attempts to support the obviousness rejection by stating that "D'Amelio et al. fails to disclose a light source comprising an LED light housing including an LED light source mounted within said LED light housing," and then states that "Thompson explicitly teaches use of such LED light source is desirable. . ." In the subsequent paragraph, the Examiner continues and states that "[e]ven with this obvious modification, the D'Amelio et al./Thompson device fails to disclose the particulars of the light coupling between the light source (34) and the optical fibers in the light post (18) and thus fails to disclose that the LED light source abuts the optical fiber bundle." Finally, the Examiner attempts to complete the hindsight reconstruction of Applicant's invention in stating, "Yarush et al. explicitly teaches abutting a light source and optical fiber proximal end to concentrate the emitted light into the fiber bundle. . ." See Office Action, page 3. Thus, the Examiner has taken a few elements from each of the cited prior art references and suggested the combination of the elements taken from those references to produce Applicant's claimed invention. Hindsight reconstruction may not be used to cobble together various elements of an invention that are cited in numerous prior art references to support a rejection based upon obviousness under 35 U.S.C. § 103(a).

The Federal Circuit has determined that "[i]t is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious." In re Fritch, 972 F.2d 1260, 1266 (Fed Cir. 1992). In rejecting claim 1, the Examiner has done just that; that is to say, the

Examiner has used the Applicant's claim as a template to stitch together numerous teachings from the prior art to find the Applicant's invention obvious under 35 U.S.C. § 103(a). None of the prior art references cited by the Examiner contains any suggestion to modify the inventions described by the references in the manner set forth by the Examiner. Clearly, the Examiner is attempting to apply the "obvious to try" test to the Applicant's invention in determining whether said invention is obvious under 35 U.S.C. § 103(a).

Regarding the "obvious to try" test, the Court of Customs and Patent Appeals has previously stated:

[A]pplication of the "obvious to try" test would often deny patent protection to inventions growing out of well-planned research which is, of course, guided into those areas in which success is deemed most likely. These are, perhaps, the obvious areas to try. But resulting inventions are not necessarily obvious. Serendipity is not a prerequisite to patentability. Our view is that "obvious to try" is not a sufficiently discriminatory test.

In re Lindell, 385 F.2d 453, 455 (C.C.P.A. 1967). Therefore, the Examiner's assertion that the Applicant's invention is obvious due to the Examiner's own belief, in hindsight, that the Applicant's use of the LED light abutting a fiber optic bundle was obvious to try does not set forth a sufficiently discriminatory test upon which the Examiner may rely to reject the Applicant's claims under 35 U.S.C. § 103(a). The prior art references cited by the Examiner do not teach, disclose, or suggest the combination of a physician's surgical headlamp to include a LED light connected to a power source as a source of light as is claimed in independent claims 1 and 5 of the present application.

In Ex parte Obukowicz, 27 U.S.P.Q. 2d 1063 (Bd. Pat. App. & Interf. 1992), the Board of Patent Appeals and Interferences stated:

[T]he specific statement by [the prior art reference] is not a suggestion [to

modify the references as asserted by the Examiner]. At best, the [prior art reference] statement is but an invitation to scientists to explore a new technology that seems a promising field of experimentation. The [prior art reference] statement is of the type that gives only general guidance and is not at all specific as to the particular form of the claimed invention and how to achieve it. Such a suggestion may make an approach “obvious to try” but it does not make the invention obvious.

Invitations to explore and general guidance as to the particular form of the invention found within the prior art are insufficient grounds for determining an invention to be obvious under 35 U.S.C. § 103(a). As the Examiner states on page 2 of the Office Action, the D’Amelio et al. reference does not “disclose a light source comprising an LED light housing including an LED light source mounted within said LED light housing,” and also “fails to disclose the particulars of the light coupling between the light source and the optical fibers in the light post and thus fails to disclose that the LED light source abuts the optical fiber bundle.” Moreover, the D’Amelio reference provides “only general guidance as to the particular form of the claimed invention or how to achieve it.” In re Roemer, 258 F.3d 1303, 1310-1311 (Fed Cir. 2001), citing In re O’Farrell, 853 F.2d 894, 903 (1988). The D’Amelio reference does not teach, disclose, or suggest the use of a LED light in combination with an endoscope having a fiber optic bundle abutting said LED light source. The suggestion of the Thompson reference to use a LED light as the light source for an endoscope may have been obvious to try, but the suggestion of “obvious to try” does not render the Applicant’s invention obvious.

Thus, for the foregoing reasons, the Examiner’s rejection of claim 1 under 35 U.S.C. § 103(a) cannot be sustained, and the Applicant respectfully requests the Examiner to withdraw the rejection and to allow the claims as amended.

In re application of: KLOOTZ, Jack

Serial No.: 10/711,005

Page 8

If there are any additional charges, including extension of time, please bill our
Deposit Account No. 13-1130.

Respectfully submitted,



Barry L. Haley, Reg. No. 25,339
Malin, Haley & DiMaggio, P.A.
1936 South Andrews Ave.
Ft. Lauderdale, Florida 33316
Tel: (954) 763-3303